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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,592	04/09/2004	Mark D. Levitt	117-P-1345USD3	1562
23322	7590	09/22/2005	EXAMINER	
IPLM GROUP, P.A. POST OFFICE BOX 18455 MINNEAPOLIS, MN 55418			AHMED, SHEEBA	
			ART UNIT	PAPER NUMBER
			1773	
DATE MAILED: 09/22/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/821,592

Applicant(s)

LEVITT ET AL

Examiner

Sheeba Ahmed

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 June 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-27,36 and 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-27,36 and 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Amendments to claims 1, 3-20, and 36 have been entered in the above-identified application. Claim 2 has been cancelled. **Claims 1, 3-27, 36, and 37 are pending.**

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 3-27, 36, and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 1 and 20 have been further amended to recite that the "topcoat is "sufficiently strip agent permeable" when "subjected to the action of a **suitable** strip agent". What is a suitable strip agent? How would one skilled in the art determine from the written disclosure, including the examples, what a suitable strip agent would be in this instance? Such a recitation in the claims gives rise to uncertainty about the scope of the claims.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 102

3. Claims 1 and 3-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Hamrock et al. (WO 98/11168).

The above rejection is maintained for the reasons of record as stated in the Office Action mailed on October 5, 2004.

4. Claims 1, 3-27, 36, and 37 are rejected under 35 U.S.C. 102(b) as being anticipated by Lauer et al. (US 5,932,350).

Lauer et al. (US 5,932,350) disclose a method for tandem coating substrate, such as cellulosic substrates, with both highly crosslinked thermoset coatings and aqueous based coatings (Column 1, lines 1-9). The substrate may be coated first with the cured coating (ii) and then the highly crosslinked coating (i) which is preferably formed from a thermoset material that is UV curable and which before cure may be a high solids composition or a waterborne composition (Column 2, lines 31-51). The UV curable coatings, after exposure to UV radiation, produce highly crosslinked coatings. It has proved difficult to adhered water-based topcoats without the use of an intermediate coating (Column 3, lines 1-6). With regards to the stripability rating limitations recited in claims 7 and 16, the Examiner takes the position that such property limitations must be inherently present in the coatings taught by Lauer et al. given that the chemical composition of the coatings and the structure of the laminate as taught by Lauer et al. and as claimed in the instant application is identical. Furthermore, Lauer's coatings must inherently be strippable "without damaging the floors" given that Lauer teaches the

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same coatings as claimed by the instant Applicants. All limitations of the claimed invention are either disclosed or inherent in the above reference.

5. Claims 1 and 3-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Wang et al. (US 5,494,707).

Wang et al. disclose a resilient floor covering comprising of a resilient support surface and a resilient wear surface adhered to said support surface and comprising an underlying wear layer based coat and an overlying wear layer top coat adhered to said wear layer base coat (Column 3, lines 61-68). The wear layer top coat is a hard thermoset UV curable blend of acrylates (Column 4, lines 7-10). The wear layer base coat has a thickness of 0.7 to 3.0 mils and the wear layer top coat has a thickness of 0.1 to 0.5 mils (Column 8, lines 35-45). Conventional substrate layer comprises materials typical of substrate layers found in the flooring art and include vinyl compositions (Column 9, lines 59-66). With regards to the stripability rating limitations recited in claims 7 and 16, the Examiner takes the position that such property limitations must be inherently present in the coatings taught by Wang et al. given that the chemical composition of the coatings and the structure of the laminate as taught by Wang et al. and as claimed in the instant application is identical. Furthermore, Wang's coatings must inherently be strippable "without damaging the floors" given that Wang teaches the same coatings as claimed by the instant Applicants. All limitations of the claimed invention are either disclosed or inherent in the above reference.

Claim Rejections - 35 USC § 103

6. Claims 20, 22-27 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrock et al. (WO 98/1 1 168) in view of Holman et al. (US 6,444,134 B1).

The above rejection is maintained for the reasons of record as stated in the Office Action mailed on October 5, 2004.

7. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hamrock et al. (WO 98/11168) in view of Holman et al. (US 6,444,134 B1) and Koreltz et al. (WO 94/22965).

The above rejection is maintained for the reasons of record as stated in the Office Action mailed on October 5, 2004.

8. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lauer et al. (US 5932,350). in view of Koreltz et al. (WO 94/22965).

Lauer et al., as discussed above, do not state that their floor finishing system further comprises a strip agent.

However, Koreltz et al. disclose compositions used to strip coatings such as floor finishes and/or greasy residues from surfaces such as floors and the composition is effective in removing multiple coatings comprising urethane/acrylic polymers (Page 1, lines 5-9 and Page 3, lines 35-37).

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Accordingly, it would have been obvious to one having ordinary skill in the art to add the strip composition disclosed by Koreltz et al. to the floor finishing system disclosed by Lauer et al. given that such compositions can be used to remove multiple coatings.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

9. Claims 1, 3-7, 11-16, 18, and 19 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-7, 11-16, 18, and 19 of copending Application No. 10/821,560. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. The claims are identical.

Response to Arguments

10. Applicant's arguments filed on June 28, 2005 with respect to the rejection of claims 1 and 3-27 under 35 U.S.C. 102(b) as being anticipated by Hamrock et al. (WO 98/11168) and the rejection of claims 20, 22-27 and 37 under 35 U.S.C. 103(a) as being

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unpatentable over Hamrock et al. (WO 98/1 1 168) in view of Holman et al. (US 6,444,134 B1) have been fully considered but they are not persuasive.

Applicants traverse the rejection of the rejection of claims 1 and 3-36 under 35 U.S.C. 102(b) as being anticipated by Hamrock et al. (WO 98/11168) and state that claim 1 addresses the coated floor after the topcoat has been applied and before it cures and hardens. However, the Examiner would like to point out that the language recited in independent claim 1 does not preclude the topcoat from being cured and hardened and hence claim 1 recites a coated floor wherein the topcoat is already cured/hardened. Furthermore, in response to the Examiner's position that the use of a two-part composition does not impart distinctive structural characteristics to the final product, Applicants direct the Examiner's attention to the Declaration filed by Robert D. P. Hei under 37 CFR 1.132 and state that the Declaration shows that the vinyl composition flooring tiles coated with a single layer of PADLOCK acrylic polymer floor finish and over coated with a two-component aqueous polyurethane composition exhibited better leveling and hardened finish appearance than the other comparative samples. However, the Examiner would like to point out that even if she agreed that the Hei Declaration shows that with a single layer of PADLOCK acrylic polymer floor finish and over coated with a two-component aqueous polyurethane composition exhibited better leveling and hardened finish appearance ***that is not the invention being claimed in the instant application. None of the claims are directed to an invention commensurate in scope with the showing in the Hei Declaration or the Specification.*** The Examiner invites the Applicants to amend the claims to recite an

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invention commensurate in scope with the showing in the Hei Declaration and the Specification. A claim reciting a coated floor with a strippable intermediate coating and a mixed two part curable composition is simply not the same as a ***vinyl*** floor tile coated with a ***single layer of PADLOCK acrylic polymer*** floor finish and over coated with a ***two-component aqueous polyurethane composition***.

Applicants further direct the Examiner to the Hei Declaration to show that Hamrock and Holman should not be combined. However, again the Examiner would like to point out that ***the claims of the instant application are invention commensurate in scope with the showing in the Hei Declaration or the Specification***.

Applicants traverse the rejection of Claims 1, 3-27, 36, and 37 under 35 U.S.C. 102(b) as being anticipated by Lauer et al. (US 5,932,350) and state that Lauer's coatings are "highly cross linked" and are "carbonyl functional" and that Lauer does not state that the coatings "can be stripped without damaging the floors". First, the Examiner would again like to point out that the language of the independent claim does not preclude the topcoat from being "highly cross linked" and/or "carbonyl functional". Second, Lauer's coatings must inherently be strippable "without damaging the floors" given that Lauer teaches the same coatings as claimed by the instant Applicants. Applicants further state that none of Lauer's working examples show a coated floor of the claimed invention. However, "the use of patents as references is not limited to what the patentees describe as their own inventions or to the problems with which they are concerned. They are part of the literature of the art, relevant for all they contain". *In re Heck*, 699 F.2d 1331, 1332-33, 216 USPQ 1038, 1039 (Fed. Cir. 1983) (quoting *In re*

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Lemelson, 397 F.2d 1006,1009, 158 USPQ 275, 277 (CCPA 1968)). A reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. *Merck & Co. v. Biocraft Laboratories*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir.), cert. denied, 493 U.S. 975 (1989). See also *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998). Disclosed examples and preferred embodiments do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. *In re Susi*, 440 F.2d 442, 169 USPQ 423 (CCPA 1971). "A known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use." *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994).

Applicants traverse the rejection of Claims 1 and 3-27 under 35 U.S.C. 102(b) as being anticipated by Wang et al. (US 5,494,707) and state that Wang does not teach that the floor can be "be stripped without damaging the floors". However, the Examiner takes the position that Wang's coatings must inherently be strippable "without damaging the floors" given that Wang teaches the same coatings as claimed by the instant Applicants.

Applicants again direct the Examiner to the Hei Declaration to show that Hamrock and Holman should not be combined with Koreltz. However, again the Examiner would like to point out that ***the claims of the instant application are invention commensurate in scope with the showing in the Hei Declaration or the Specification.***

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Lastly, with regards to the double patenting rejection, the Examiner would like to point out that where the claims of an application are ***substantively the same*** as those of a first patent (or another application), they are barred under 35 U.S.C. 101 - the statutory basis for a double patenting rejection. A rejection based on double patenting of the **“same invention”** type finds its support in the language of 35 U.S.C. 101.

In conclusion, all rejections are maintained for the reasons of record and the Examiner again invites the Applicants to amend the claims to recite an invention commensurate in scope with the showing in the Hei Declaration and the Specification, i.e., a claim having at least a ***vinyl*** floor tile coated with a ***single layer of PADLOCK acrylic polymer*** floor finish and over coated with a ***two-component aqueous polyurethane composition***.

Conclusion

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (571)272-1504. The examiner can normally be reached on Mondays and Thursdays from 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on (571)272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sheeba Ahmed

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September 15, 2005